REMARKS

Claims 5-7, 14-18 and 23 are cancelled. Claims 1-4, 8-13, 19-22, and 24-26 are amended. New claims 27 and 28 are presented for consideration. No new subject matter is added. Claims 1-4, 8-13, 19-22 and 24-28 are now pending in the application. Reconsideration and allowance of the pending claims is requested in light of the following remarks.

In the Claims

The amendment of claim 1 is fully supported by the previous version of claim 1 and the original application at, e.g., page 10, line 26 to page 11, line 17; and FIGs. 1 and 2. The amendments to claims 2-4, 8-11, and 26 are fully supported by the previous versions of claims 2-4, 8-11, and 26 as well as the previous version of claim 17.

The amendment of claims 12 and 13 is fully supported by the previous version of claims 12 and 13.

The amendment of claims 19-21 is fully supported by the previous version of claims 19-21.

The amendment of claim 24 is fully supported by the previous version of claim 24.

The amendment of claim 25 is fully supported by the previous version of claim 25 and the original application at, e.g., page 11, lines 10-12.

New claim 27 is fully supported by the previous version of claim 23.

New claim 28 is fully supported by the original application at, e.g., page 12, lines 1-11.

Claim Rejections – 35 USC § 103

Claims 1-6 and 8-25 are rejected under 35 USC 103(a) as being unpatentable over U.S. Pat. No. 6,003,078 to Kodimer et al. ("Kodimer") in view of U.S. Pat. No. 4,905,196 to Kirrmann ("Kirrmann"). The applicant disagrees.

Contrary to claim 1, Kodimer fails to teach or suggest that each of the network devices coupled to the packet switching network by the second interface line includes at least one hardware subsystem, at least one software subsystem, and embedded software that is operable to collect and analyze status information from the at least one hardware subsystem and the at least

one software subsystem to detect a problem with any one of the hardware and software subsystems or the second interface line.

The Office Action evidently suggests that the recited network devices coupled to the packet switching network by the second interface line correspond to Kodimer's copier 11, multi-device controller (MDC) 12, and network interface board (NIB) 14 (FIG. 1). However, the Office Action only discusses the capabilities of Kodimer's NIB 14. Thus, contrary to claim 1, the Office Action does not establish that each of the alleged network devices has embedded software with the capabilities recited in the claim. Kirrmann is not alleged to teach this feature, nor does it.

For the above reason, the combination of Kodimer and Kirrmann fails to establish *prima facie* obviousness for claim 1 because it does not teach or suggest all the features recited in the claim. MPEP 2143.03.

Claim 1 further recites that the embedded software included in each network device is operable to collect status information from the at least one hardware subsystem and the at least one software subsystem included in each network device. Nowhere does Kodimer teach or suggest that the NIB 14 possesses these features. See, e.g., column 4, lines 11-22. Nowhere does Kodimer teach or suggest that the copier 11 or the MDC 12 possesses these features.

For this additional reason, the combination of Kodimer and Kirrmann fails to establish *prima facie* obviousness for claim 1 because it does not teach or suggest all the features recited in the claim. MPEP 2143.03.

Claim 1 further recites that each of the network devices is capable of sending, in response to the detection of the problem with any one of the hardware and software subsystems or the second interface line, a first message to the technical center without interrupting the normal operation of the network device, the first message including the status information.

Contrary to this feature, the NIB 14 does not detect problems with any one of the hardware and software subsystems included in the NIB 14, it merely relays status requests from the LAN 15 to the copier 11, and transmits status information from the copier back to the LAN 15. See, e.g., column 4, lines 11-22.

For this additional reason, the combination of Kodimer and Kirrmann fails to establish *prima facie* obviousness for claim 1 because it does not teach or suggest all the features recited in the claim. MPEP 2143.03.

Claims 2-4 and 8-11 are allowable over the combination of Kodimer and Kirrmann at least because any claim that depends from a nonobvious independent claim is also nonobvious. MPEP 2143.03.

Further regarding claim 2, the Office Action proposes that Kodimer teaches that the first message is an email at column 13, lines 26-28. However, the email described at column 13, lines 26-28 is actually a follow-up email to a first message. The first message is described at column 13, lines 11-17 as a packet containing an HTML file. Consequently, Kodimer does not teach that a first message is an email. For this additional reason, claim 2 is allowable over the combination of Kodimer and Kirrmann. MPEP 2143.03.

Further regarding claim 3, the Office Action proposes that Kodimer teaches that the first message is a fax transmission at column 1, lines 16-19. However, the lines the Office Action refers to are descriptions of how service requests are conventionally filed *by people*, not how a network device sends a first message. For this additional reason, claim 3 is allowable over the combination of Kodimer and Kirrmann. MPEP 2143.03.

Claims 5 and 6 are cancelled.

Further regarding claim 9, the claim recites a hardware health status monitor subsystem, a software health status monitor subsystem, and a remote diagnostic embedded process subsystem in communication. Kodimer does not teach any of these devices. Further, Kodimer does not teach or suggest that the status of the software of the copier is monitored at all. Kodimer only teaches that physical hardware conditions are monitored such as usage and motor failures. For this additional reason, claim 9 is allowable over the combination of Kodimer and Kirrmann. MPEP 2143.03.

Claim 12 recites that the first message is transmitted to the technical support center prior to the failure of the one of the hardware subsystem and software subsystem.

Kodimer teaches that network copier 11 can detect a condition for which service is required (column 12, lines 52-53). Kodimer further teaches that the condition can include a motor failure (column 12, lines 56-57). Kodimer teaches that after the condition (such as a motor failure) is detected, information specifically relating to the detected condition is output from copier 11 to NEB 14 (column 12, line 66 to column 13, line 1).

Thus, contrary to claim 12, Kodimer teaches that information is transmitted after the detected condition (such as motor failure) occurs. Also contrary to claim 1, Kodimer teaches that the copier 11 transmits information relating to the detected condition to the NEB 14, not to the alleged technical support center. Kirrmann does not teach or suggest these features of claim 12.

For these reasons, the combination of Kodimer and Kirrmann fails to establish *prima facie* obviousness for claim 12 because it does not teach or suggest all the features recited in the claim. MPEP 2143.03.

Claims 13, 19-22, and 26 are allowable over the combination of Kodimer and Kirrmann ate least because any claim that depends from a nonobvious independent claim is also nonobvious. MPEP 2143.03.

Claims 14-18 are cancelled.

Further regarding claim 19, the claims recite a hardware health status monitor subsystem, a software health status monitor subsystem, and a remote diagnostic embedded process subsystem in communication. Kodimer does not teach any of these devices. Further, Kodimer does not teach or suggest that the status of the software of the copier is monitored at all. Kodimer teaches that physical hardware conditions are monitored such as usage and motor failures. For this additional reason, claim 19 is allowable over the combination of Kodimer and Kirrmann. MPEP 2143.03.

Claim 24 recites sending a first message from the network device to the technical support center, the first message notifying the technical support center of the problem, where the problem is associated with one of the hardware subsystem, the software subsystem, and the interface line. Claim 24 further recites that the first message includes status information for both the hardware subsystem and the software subsystem.

Kirrmann is not alleged to teach these features of claim 24, nor does it teach them.

Kodimer teaches that network copier 11 can detect a condition for which service is required (column 12, lines 52-53). Kodimer further teaches that the condition can include a motor failure (column 12, lines 56-57). Kodimer teaches that after the condition (such as a motor failure) is detected, information *specifically relating to the detected condition* is output from copier 11 to NEB 14 (column 12, line 66 to column 13, line 1; emphasis added). Contrary

to claim 12, nowhere does Kodimer indicate that information specifically relating to a first subsystem is output from the copier 11 when a condition specifically relating to a second subsystem is detected.

For this reason, the combination of Kodimer and Kirrmann fails to establish *prima facie* obviousness for claim 24 because it does not teach or suggest all the features recited in the claim. MPEP 2143.03.

Regarding claim 25, the office action proposes that the limitation "before failure of the one of the hardware and software subsystems" is inherent in Kodimer.

"When relying on the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied art." MPEP 2112(IV), *citing* Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter., 1990), emphasis in original. Furthermore, the fact that a certain result <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP 2112(IV), *citing* In re Rijckaert, 9 F.3d 1531, 1534 (Fed. Cir. 1993), emphasis in original.

There Office Action presents no basis in fact or technical reasoning to conclude that Kodimer necessarily teaches that a first message is sent from the network device after detection of the problem with one of the hardware and software subsystems and before failure of the one of the hardware and software subsystems. In fact, Kodimer specifically teaches that a first message is not sent until after a motor failure is detected (column 12, lines 52-67).

Kirrmann discusses a method and storage device for saving computer status during interrupt by saving a computer status, including variables of useful programs, register status of the processor, and the register status of the input/output devices. Kirrmann operates by dividing useful work into 'recovery blocks' and saving recovery points to allow resumption of computer operation after recovery from a failure where the recovery points represent the last known memory status prior to any failure. Kirrmann does not teach or even suggest indicating status after a fault occurs and before device failure. In fact, in Kirrmann, if a failure occurs in any recovery block, the processor terminates an interrupted job and attempts, *after a repair*, to restore to the last known memory status prior to any failure (recovery point). Therefore Kirrmann does not cure the deficiencies of Kodimer.

Consequently, the combination of Kodimer and Kirrmann fails to establish *prima facie* obviousness for claim 25 because it does not teach or suggest all of the features recited in the claims. MPEP 2143.03.

Claim 26 is rejected under 35 USC 103(a) as being unpatentable over Kodimer and Kirrmann, and further in view of U.S. Pat. No. 3,925,764 A to Wiesenewsky ("Wiesenewsky"). The applicant disagrees.
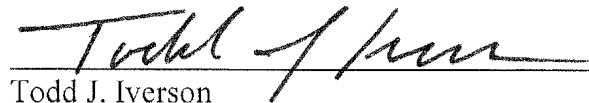
Claim 26 depends from claim 1, and inherently contains the features of claim 1. Consequently, claim 26 is allowable over the combination of Kodimer, Kirrmann, and Wiesenewsky at least because any claim that depends from a nonobvious independent claim is also nonobvious. MPEP 2143.03.

CONCLUSION

For the reasons presented above, reconsideration and allowance of the pending claims is requested. Please telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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